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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,548	12/13/2000	Uwe Schumann	BEIERSDORF 685-WCG	5636

7590

07/08/2003

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New York, NY 10017

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/08/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

A8-15

**Office Action Summary**

Application No.

09/736,548

Applicant(s)

SCHUMANN ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

***Response to Amendment***

3. Claims 1, 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. (5667893) either individually, or in view of Wiest et al. (US 4322516) for claims 6 and 11, substantially for the reasons set forth in the NOTE of Paper No. 13, section 3 of Paper No. 10 and sections 5 and 6 of Paper No. 6, together with the following additional observations.

In the Appeal Brief dated 5/23/2003, Applicants' contention that "the primary component of the photopolymerizable epoxy composition of the Kinzer reference is a plurality of epoxies (see col. 2, Summary of the Invention) whereas the applicants' crosslinked epoxy is comprised of an epoxy component and an amine component" (pages 3-4, bridging paragraph) is not persuasive. The Examiner repeats that (see page 2 of Paper No. 13 and page 3 of Paper No. 6) that Kinzer teaches that a plurality of epoxy resins including bisphenol A epoxy resins, cycloaliphatic epoxy resins, and aliphatic epoxy resins or mixtures can be used (column 2, lines 20-24). The epoxy coating compositions may also include hardeners (i.e., amines), etc. (column 6, lines 17-21). Clearly Kinzer's teachings is not limited to a plurality of epoxies, and

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encompasses the use of a epoxy component with hardeners (e.g., amines). As to Applicants' argument that "the characterization of hardeners as being equivalent to amines comes from the examiner *not* from the teachings of Kinzer" (Appeal Brief, page 4, third full paragraph), the Examiner notes that it is old and well known to one of ordinary skill in the epoxy art that the term "hardeners" encompass "amines", which is used to crosslink and consequently harden the epoxy resins. Note also as evidence of the state of the art Sobel (US 3609190), which is directed to polyaminated derivatives, i.e., polyamines (Abstract). Sobel teaches that the products (i.e., formula at column 1, lines 15-20) in which Z represents an amine group form interesting hardeners for epoxy resins (column 1, lines 61-62). It should be noted that Applicants failed to raise the aforementioned "hardener" issue in the earlier Response dated 11/27/2002 to the Office action dated 5/29/2002 (Paper No. 6).

With respect to Applicants' argument that "it is unclear that Kinzer actually teaches a crosslinked epoxy resin. Kinzer at best teaches that their epoxy compositions are "photopolymerized". However, there is no indication that this is equivalent to being crosslinked." (Appeal Brief, page 4, first full paragraph), the Examiner reiterates (see page 3 of Paper No. 6) that Kinzer expressly teaches that "The formation of polymerized, crosslinked epoxy materials is well known. A variety of methods for polymerizing these species have been disclosed in the prior art, including the polymerization of epoxy materials. The earliest reports of polymerization of epoxy materials relied upon thermal curing using, e.g., polyfunctional amines" (column 1, lines 19-24); further, Kinzer also expressly teaches that tape backings comprise a substrate

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coated or impregnated with a blend of epoxy materials, and the backing is fully cured (i.e., crosslinked) after an irradiation (column 2, lines 40-52), Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument that "there is no teaching or suggestion that (1) the adjuvants are required elements of Kinzer's invention; (2) hardeners are preferably selected from the Markush group of adjuvants; and (3) the hardener must be amine." (Appeal Brief, page 5), the Examiner notes that Applicants' argument is not persuasive since it assumes that an anticipation rejection, not an obvious rejection, has been made. It should also be noted that Kinzer teaches the invention as claimed, <sup>and</sup> in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute Kinzer's photo cured epoxy coating with an amine cured (or crosslinked) epoxy coating, as taught by Kinzer's disclosure of well known prior art, motivated by the desire to use a well known and commonly available coating.

With respect to Applicants' argument that Kinzer teaches the limitation "in amounts such that they do not interfere with the polymerization of epoxies." (Appeal Brief, page 5, last paragraph), the Examiner notes that Applicants again assumes that an anticipation rejection, not an obvious rejection, has been made.

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
June 30, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*